

Remarks

Claims 1-5, 7, and 8 were pending in the subject application. By this Amendment, the applicants have amended claims 1, 7, and 8. No new matter has been added by these amendments. Support for the amendments can be found throughout the original specification (see, for example, page 4, line 25 through page 5, line 15). Accordingly, claims 1-5 and 7-8 are before the Examiner for further consideration.

The amendments to the claims have been made in an effort to lend greater clarity to the claimed subject matter and to expedite prosecution. These amendments should not be taken to indicate the applicant's agreement with, or acquiescence to, the rejections of record. Favorable consideration of the claims now presented, in view of the remarks and amendments set forth herein, is earnestly solicited.

Claims 1-5 and 7-8 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite. By this Amendment, claims 1, 7, and 8 have been amended to remove the phrase "high modulus." The applicants submit that the claims particularly point out and distinctly claim the subject matter regarded as the invention. Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejection under §112, second paragraph.

Claim 7 has been rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Miyazawa *et al.* (JP 2000-303259). The applicants respectfully request reconsideration.

By this Amendment, claim 7 has been amended to recite that, in the process of preparing the elastic fiber, "the cellulose acetate is first dissolved in an organic solvent, the resulting solution is homogeneously stirred for 7-8 hours and then added to the polyurethane or polyurethaneurea solution to obtain a mixture... wherein the homogeneous stirring time of the mixture is increased by 30 minutes for each increase of 1% by weight of the cellulose acetate added to the mixture." The latter limitation is discussed at page 5, lines 12-13, and clarified in Examples 1-3, in which the stirring time goes from 2 hours in Example 1 (for 1 wt % cellulose acetate) to 4 hours in Example 2 (for 5 wt % cellulose acetate) to 6.5 hours in Example 3 (for 10 wt % cellulose acetate).

As discussed at page 5, lines 2-13, the advantageous process used to produce the elastic fiber in the present invention, including the homogeneous stirring for 7-8 hours of the solution resulting from dissolving the cellulose acetate in an organic solvent, is important for achieving the advantageous properties of the subject invention, including increase of modulus and improvement in alkali resistance and heat resistance. These process parameters, required by claim 7, are not disclosed or contemplated by Miyazawa *et al.*

In addition, the applicants note that the claimed elastic fiber, produced by the process of claim 7, exhibits high alkali resistance (as noted at page 5, lines 2-13 of the subject specification), while Miyazawa *et al.* teach preparing their elastic fiber by treating an acetyl-cellulose-containing fiber with an alkali (see, e.g., paragraph [0045]). Thus, not only is the fiber of Miyazawa *et al.* not highly alkali resistant, altering the process steps in Miyazawa *et al.* to arrive at the claimed invention would render the process inoperable for its intended purpose. A skilled artisan would not have modified Miyazawa *et al.* to attain a fiber with high alkali resistance since the final fiber could not even be produced by the Miyazawa *et al.* method that includes treating a fiber with an alkali.

As the Examiner is aware, it is a basic premise of patent law that in order to anticipate, a single reference must disclose within the four corners of the document each and every element and limitation contained in the rejected claim. *Scripps Clinic & Research Foundation v. Genentech Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). As discussed above, Miyazawa *et al.* do not disclose certain aspects of the claimed invention.

Moreover, the applicants submit that a skilled artisan would not have had any reason to modify the Miyazawa *et al.* process and fiber to arrive at the claimed invention.

Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejection of claim 7 based on Miyazawa *et al.*

Claim 7 has been rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Watanabe *et al.* (U.S. Patent No. 4,439,599). The applicants respectfully request reconsideration.

By this Amendment, claim 7 has been amended to recite that, in the process of preparing the elastic fiber, "the cellulose acetate is first dissolved in an organic solvent, the resulting solution is

homogeneously stirred for 7-8 hours and then added to the polyurethane or polyurethaneurea solution to obtain a mixture... wherein the homogeneous stirring time of the mixture is increased by 30 minutes for each increase of 1% by weight of the cellulose acetate added to the mixture.”

As discussed at page 5, lines 2-13, the advantageous process used to produce the elastic fiber in the present invention, including the homogeneous stirring for 7-8 hours of the solution resulting from dissolving the cellulose acetate in an organic solvent, is important for achieving the advantageous properties of the subject invention, including increase of modulus and improvement in alkali resistance and heat resistance. These process parameters, required by claim 8, are not disclosed or contemplated by Watanabe *et al.*

As discussed above, it is a basic premise of patent law that in order to anticipate, a single reference must disclose within the four corners of the document each and every element and limitation contained in the rejected claim. *Scripps, supra*. Watanabe *et al.* do not disclose certain aspects of the claimed invention.

Moreover, the applicants submit that a skilled artisan would not have had any reason to modify the Watanabe *et al.* process and fiber to arrive at the claimed invention.

Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejection of claim 7 based on Watanabe *et al.*

Claims 1-5 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Miyazawa *et al.* in view of Brotherton *et al.* (U.S. Patent No. 3,256,220). The applicants respectfully request reconsideration.

By this Amendment, claim 1 has been amended to recite that, in the process of preparing the elastic fiber, “the cellulose acetate is first dissolved in an organic solvent, the resulting solution is homogeneously stirred for 7-8 hours and then added to the polyurethane or polyurethaneurea solution to obtain a mixture... wherein the homogeneous stirring time of the mixture is increased by 30 minutes for each increase of 1% by weight of the cellulose acetate added to the mixture.”

As discussed at page 5, lines 2-13, the advantageous process used to produce the elastic fiber in the present invention, including the homogeneous stirring for 7-8 hours of the solution resulting from dissolving the cellulose acetate in an organic solvent, is important for achieving the

advantageous properties of the subject invention, including increase of modulus and improvement in alkali resistance and heat resistance. These process parameters, required by claim 1, are not taught or suggested anywhere in the combination of cited references.

Moreover, the applicants respectfully submit that, absent the applicants' own disclosure, a skilled artisan would not have had a reason to modify the Miyazawa/Brotherton process to arrive at the claimed invention.

Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejection under §103 of claims 1-5 based on Miyazawa *et al.* and Brotherton *et al.*

Claim 8 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Mares *et al.* (U.S. Patent No. 5,531,998) in view of Miyazawa *et al.* The applicants respectfully request reconsideration.

By this Amendment, claim 8 has been amended to recite that, in the process of preparing the elastic fiber, "the cellulose acetate is first dissolved in an organic solvent, the resulting solution is homogeneously stirred for 7-8 hours and then added to the polyurethane or polyurethaneurea solution to obtain a mixture... wherein the homogeneous stirring time of the mixture is increased by 30 minutes for each increase of 1% by weight of the cellulose acetate added to the mixture."

As discussed at page 5, lines 2-13, the advantageous process used to produce the elastic fiber in the present invention, including the homogeneous stirring for 7-8 hours of the solution resulting from dissolving the cellulose acetate in an organic solvent, is important for achieving the advantageous properties of the subject invention, including increase of modulus and improvement in alkali resistance and heat resistance. These process parameters, required by claim 1, are not taught or suggested anywhere in the combination of cited references.

Moreover, the applicants respectfully submit that, absent the applicants' own disclosure, a skilled artisan would not have had a reason to modify the Mares/Miyazawa process to arrive at the claimed invention.

Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejection under §103 based on Mares *et al.* and Miyazawa *et al.*

Claim 8 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Mares *et al.* in view of Watanabe *et al.* The applicants respectfully request reconsideration.

By this Amendment, claim 8 has been amended to recite that, in the process of preparing the elastic fiber, “the cellulose acetate is first dissolved in an organic solvent, the resulting solution is homogeneously stirred for 7-8 hours and then added to the polyurethane or polyurethaneurea solution to obtain a mixture... wherein the homogeneous stirring time of the mixture is increased by 30 minutes for each increase of 1% by weight of the cellulose acetate added to the mixture.”

As discussed at page 5, lines 2-13, the advantageous process used to produce the elastic fiber in the present invention, including the homogeneous stirring for 7-8 hours of the solution resulting from dissolving the cellulose acetate in an organic solvent, is important for achieving the advantageous properties of the subject invention, including increase of modulus and improvement in alkali resistance and heat resistance. These process parameters, required by claim 1, are not taught or suggested anywhere in the combination of cited references.

Moreover, the applicants respectfully submit that, absent the applicants’ own disclosure, a skilled artisan would not have had a reason to modify the Mares/Watanabe process to arrive at the claimed invention.

Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejection under §103 based on Mares *et al.* and Watanabe *et al.*

In view of the foregoing remarks and the amendment above, the applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

The applicants also invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



Louis C. Frank  
Patent Attorney  
Registration No. 60,034  
Phone: 352-375-8100  
Fax No.: 352-372-5800  
Address: P.O. Box 142950  
Gainesville, FL 32614-2950

LCF/la

Attachment: Request for Continued Examination